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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/358,788 07/22/99 HELLER

M 244/299

EXAMINER

HM22/0206

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MARSCHEL, A
ART UNIT PAPER NUMBER

1631
DATE MAILED:

4
02/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/358,788

Applicant(s)

Heller et al.

Examiner

Ardin Marschel

Group Art Unit

1631



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 49-78 is/are pending in the application
- ~~Of the above, claim(s) 1-48 have been canceled. is/are withdrawn from consideration~~
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 49-78 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

It is noted that a potential interference exists between the instant application and Konrad (P/N 5,789,167) and will be taken up for consideration after the issues summarized hereinbelow due to no allowable claims as this time.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present claims are all directed to methods whereas, in conflict, the title is directed to systems, devices, and diagnostics.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because no submission of computer readable form sequences etc. has been submitted. Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action.

Claims 49-78 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

It is noted that the following NEW MATTER is present in the pending claims which has been determined after consideration of the entire instant specification as filed. In claims 49-58 the limitations directed to a magnetic field and/or magnetic particle practice lacks written description in the instant application, as filed. In claims 59-64 the usage of first and second oligonucleotide sequences as probes in a sandwich hybridization assay format lacks written description in the instant application as filed. In claims 65-78 the extending of sample DNA in the direction of the field lacks written basis in the instant application as filed. These limitations thus are NEW MATTER in that they have not been found as filed.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

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Art Unit: 1631

Any inquiry of a general nature or relating to the status of this application should be directed to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 26, 2000

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER